

1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte JUNICHIRO SUZUKI,
11 KAZUTAKA KATAYAMA,
12 and HIROAKI ITO
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15 Appeal 2007-2023
16 Application 10/757,453
17 Technology Center 1700
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20 Oral Hearing Held: July 11, 2007
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24 Before CHUNG K. PAK, CHARLES F. WARREN, and
25 LINDA M. GAUDETTE, Administrative Patent Judges
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MAILED

JUL 30 2007

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

1 The above-entitled matter came on for hearing on Wednesday,
2 July 11, 2007, commencing at 10:45 a.m., at the United States Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah
4 Rinaldo, RPR, Notary Public, CCR No. 0315067.

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6 THE CLERK: Calendar number 17, appeal number 2007-2023.
7 Attorney is Mr. Geselowitz.

8 JUDGE PAK: Mr. Geselowitz, good morning. We have two
9 interns, Mr. Joe Arand and Adam Swain, who will be observing the hearing.
10 And we have a court reporter, Debbie Rinaldo, who will be transcribing the
11 hearing, and that transcript will become part of the record.

12 And you know the rule, you have 20 minutes to argue your
13 case.

14 MR. GESELOWITZ: Thank you very much. Thank you for
15 giving me the opportunity to present my case. So what I would like to do
16 today is very simply to review the rejection, review our arguments and
17 simplify them, clarify them. If possible, of course, answer any questions
18 that you have.

19 So very simply, review. The rejection is of claims 1 to 8 over
20 two references, Nishino, et al., 278 and the Nishi 575. So let's look at the
21 Nishino, et al., 278 patent. First of all, that forms the basis of the rejection.

22 Basically we concur with the examiner's general comments
23 regarding this reference. If you look at the main figure, innermost layer 10
24 of Nishino would correspond to the inner layer in claim 1. Adhesive layer
25 11 would correspond to the adhesive layer. Middle layer 12 would
26 correspond to the low carbon fuel permeability layer.

1 Now, Nishino's innermost layer 10 discussed on column 5,
2 starting on line 47, that can be a fluoro-type resin or a polyamide resin. So
3 the examiner is taking this as a suggestion for the fluoro resin which could
4 be the inner layer of claim 1.

5 Now, the point is -- and we concur with the examiner that there
6 is no teaching or suggestion in the reference in Nishino that for a functional
7 group on the resin of the inner layer, as required by claim 1 which says the
8 fluoro resin having a functional group.

9 So switching to the Nishi reference, and the examiner -- Nishi,
10 of course, teaches two layers, an inner layer made of fluoro resin and an
11 outer layer adjacent thereto. Now, the examiner points out the fluoro resin
12 may have a functional group. That can be seen on paragraph 023, and we
13 concur with that.

14 So the rejection, of course, is based on the examiner saying
15 modify Nishino's inner layer, which can be a fluoro resin, although it doesn't
16 suggest a function group, to have the functional group that's present in
17 Nishi's inner layer.

18 So where we disagree with the examiner is to whether there
19 really is any motivation to combine the references in this way. And again,
20 you can find the basic statement of the examiner's motivation for the
21 combination of references. It's stated several places during prosecution.

22 But for example, in the examiner's answer, page 5, last
23 paragraph, the examiner states that it provides -- that Nishi provides the
24 fluoro resin with increased adhesiveness to materials like polyester and
25 polyamide, and therefore, that Nishi would suggest -- and this is the key --
26 quote, increasing the adhesive bond between the fluoro resin and the

1 polyester and polyamide of the adhesive layer in Nishino.

2 And that really is where we disagree with the examiner. Our
3 feeling is that even if there is a general suggestion in Nishi that adding the
4 functional group does increase adhesiveness to polyamides, this does not
5 provide suggestion or motivation for modifying Nishino's structure. And
6 basically there is too many reasons for this.

7 First of all, Nishi specifically teaches against an adhesive layer.
8 So the examiner is trying to say that Nishi's general structure can be used for
9 modifying an inner layer that would contact an adhesive layer that would
10 contact an outer layer.

11 But Nishi specifically says there should not be an adhesive
12 layer. In paragraphs 10, 11 and 14, Nishi specifically teaches an inner layer
13 and an outer layer adjacent thereto, and contact no adhesive layer. Nishi
14 specifically states in paragraphs 10 and 131 that the invention is without use
15 of an adhesive or without an adhesive layer between the inner layer and the
16 outer layer.

17 And in fact, in paragraph 7 and 8 of Nishi specifically discusses
18 the problems associated with an adhesive layer, why there is no adhesive
19 layer in the present invention.

20 On the other hand, if you look at Nishino, the motivation to
21 modifying Nishino is based on the concept that there is some sort of lack of
22 adhesiveness between the innermost layer 10 and the adhesive layer 11.

23 But Nishino does not indicate -- Nishino's invention, lack of
24 adhesiveness, is a problem. And Nishino appears to indicate that this
25 invention works very well. It gives a number of advantages to his invention.

26 So therefore, the technical inference that functional groups on

1 the fluoro resin improve the melt adhesiveness, which is what Nishi says of
2 the fluoro resin around two polyamides. That does not provide a motivation
3 for the specific proposed modification of Nishino.

4 And so basically our basic argument is that the references to
5 each mutually exclusive solutions indicates that Nishi, two layers without an
6 adhesive layer, that works. In the case Nishino, three layers the minimum,
7 one of them being an adhesive layer, that works. There is no -- based on
8 suggestion either to modify the other.

9 And if I may also note that the problems that Nishi lists with
10 having an adhesive layer in the earlier paragraphs, paragraph 7 and 8, are
11 that having an adhesive layer increases the cost of the invention. Well,
12 Nishino already has an adhesive layer.

13 JUDGE GAUDETTE: If I could just ask you, in Nishino they
14 talk about the middle layer 12, and it's column 8, lines 17 to 24. It talks
15 about adding compounds having a functional group for improving adhesion
16 to other layers.

17 And while they don't talk about adding functional groups to the
18 inner layer, it seems to me that that's a suggestion that the addition of
19 functional groups could be used in conjunction with other adhesive layers.

20 MR. GESELOWITZ: But isn't that interesting that he doesn't
21 talk about adding a functional group to the inner layer. He obviously doesn't
22 think that's necessary. Or clearly either that or it never occurred to him. I
23 can't say why he exactly doesn't, yet he specifically does not.

24 If you look at the description for the innermost layer, column 5,
25 line 47, column 6, he lists a number of basic resins and says basically that
26 they are adequate in adhesion.

1 If you look at column 6, lines 13 to 15, he does discuss the
2 adhesion aspect, but basically says PVDF and ETFE are especially
3 preferable in view of their molding facility and adhesion to other resins,
4 basically implies that there is adequate adhesion.

5 JUDGE GAUDETTE: I guess the idea is that Nishino clearly
6 didn't recognize that you would want to add the functional group to the inner
7 layer, but then Nishi comes along and finds out that if you add that
8 functional group, you can improve adhesion.

9 So one of ordinary skill in the art, then, looking at both
10 references, would say, well, why wouldn't I want to improve the adhesion by
11 adding the functional group?

12 MR. GESELOWITZ: I would take the opposite tack. Nishino
13 is well aware of functional groups. He saw no advantage. There is no
14 reason to add them at all. His worked perfectly adequately without the
15 addition. In fact, the addition of functional groups to the middle layer for
16 adhering to the layers, that goes beyond that.

17 JUDGE GAUDETTE: Well, it says adjacent layers.

18 MR. GESELOWITZ: He has five layers, I think. So he has a
19 layer outside the middle layer which would correspond to the outer layer in
20 our fuel pump layer in our invention. So he was talking about adhesion to
21 subsequent layers --

22 JUDGE GAUDETTE: I think he doesn't say subsequent layers.
23 I think it just says adjacent layers. So technically it could be the inner layer
24 as well.

25 MR. GESELOWITZ: But again, Nishino specifically does
26 refer to this adhesive layer as an adhesive layer. Its purpose is adhesion.

1 There is no doubt about it. Just as in our invention, the purpose of that
2 adhesive layer is adhesion.

3 JUDGE PAK: Counsel, one question. With respect to Nishi
4 you indicated it teaches away from using an adhesive layer together with the
5 fluoro resin having functional group. The original states teaching away is
6 because Nishi teaches not employing an adhesive layer because of the cost
7 involved?

8 MR. GESELOWITZ: He has several reasons that he gives.
9 Again, this is basically taken from paragraph 7 and 8 of the Nishi reference.
10 We can -- and I guess paragraph 9 as well.

11 He basically says that high cost is at the bottom of paragraph 8.
12 In paragraph 9 he discusses -- he says the fuel hose is basically subjected to
13 bending at various angles over the entire length of a straight tube produced
14 by extrusion molding, implying that it's going to be somehow premade at
15 some angle.

16 I think that's what he's implying here in order to adapt it to
17 configuration with spatial restrictions and specific structure of each
18 automobile. And the bending of the hose not only increases a process step
19 but wrinkles may therefore be formed.

20 Once wrinkles are formed, the stress would be concentrated in
21 such a portion whereby there will be a problem that the useful life of the
22 hose tends to be substantially short.

23 So clearly he is implying that at least in general he doesn't think
24 you should have an adhesive layer. And in his invention clearly he does not
25 have an adhesive layer and says you should not.

26 JUDGE WARREN: That's not essentially teaching away, is it?

1 MR. GESELOWITZ: Well, I think it is.

2 JUDGE WARREN: It says he doesn't require it.

3 MR. GESELOWITZ: He does. He says on two occasions --
4 three occasions he specifically says it's the inner layer with the outer layer
5 adjacent thereto. And on two occasions he says without use of an adhesive.

6 JUDGE WARREN: I think there was an adhesive in In re
7 Gurley where the Court essentially said that just because that particular
8 adhesive doesn't work as well does not mean one of ordinary skill in the art
9 wouldn't use it.

10 I think in that same decision they basically said that in order for
11 a reference to teach away, it essentially has to tell you not to do it.

12 MR. GESELOWITZ: Well, it does say not to do it.

13 JUDGE WARREN: I don't see that. It just says where you
14 have a cost problem and you may have a wrinkle, you may have factors that
15 may affect the effectiveness. I'm not sure I see something that says that one
16 of ordinary skill in the art, thou shall not use this.

17 MR. GESELOWITZ: What about paragraph -- as close as it
18 comes is paragraphs 10 and 131 where he specifically says without using an
19 adhesive.

20 JUDGE WARREN: It says that he would rather use the
21 substitute of fluoro resin without using an adhesive, but I'm not sure I see the
22 teaching away in this which amounts to a teaching away recognized by our
23 reviewing court in such cases as In re Kahn, In re Fulton, In re Gurley.

24 MR. GESELOWITZ: Well, I can't point out anything more
25 than his specific statement that without using an adhesive is the way his
26 invention is supposed to be done. His invention clearly is designed, after all,

1 why would he have --

2 JUDGE WARREN: It's just a preference.

3 MR. GESELOWITZ: It's not just a preference. The whole
4 point of having functional groups is to achieve contact with the outer layer
5 because there is no adhesive present. That's what the purpose of the
6 adhesive is, to accomplish the very task he's accomplishing without an
7 adhesive.

8 JUDGE WARREN: Let me ask you this, then. You are saying
9 that your inner layer comprises of fluororesin having a functional group. It
10 doesn't say how much there has -- you have to use of this, right?

11 MR. GESELOWITZ: That's true. Claim 1 doesn't say that.

12 JUDGE WARREN: So essentially you could, to go with your
13 current reasoning, if you don't use very much of this, it may not have much
14 of a difference at all.

15 MR. GESELOWITZ: I suppose that's possible. And since the
16 argument is based on the fact that there is no suggestion in the prior art for
17 these, that doesn't actually affect my argument.

18 JUDGE PAK: We have no questions, unless you want to make
19 a final statement.

20 MR. GESELOWITZ: No. I thank you very much for your
21 time.

22 JUDGE PAK: Thank you for coming.

23 (Whereupon, the proceedings at 11:02 a.m. were concluded.)